

## REMARKS

### I. Introduction

Claims 5-6 and 29-45 are currently pending in the present application. Claims 5 and 29-45 are independent. The status of the pending claims is as follows:

(A) claims 5-6, 29, 34, and 41 are allowed,

(B) claims 30 and 35 stand rejected under 35 U.S.C. §102(b) for allegedly being anticipated by U.S. Patent No. 5,732,398 (hereinafter "Tagawa"), and

(C) claims 31-33, 35-40, and 42-45 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Tagawa.

Upon entry of this amendment, which is respectfully requested, independent claims 30, 35, and 42 will be cancelled without prejudice or disclaimer, independent claims 32, 37, and 44 will be amended, and new claims 46-50 will be added. No new matter is believed to be introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

### II. The Examiner's Rejections

Claims 30-33, 35-40, and 42-45 stand rejected, as being anticipated by or unpatentable over, Tagawa. Applicants respectfully traverse all grounds for rejection, to be addressed separately, as follows.

#### A. Rejections Under §102(b) – Tagawa

Claims 30 and 35 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Tagawa. As Applicants have cancelled claims 30 and 35 with this amendment, this ground for rejection is moot. Applicants do, however, address this ground for rejection with respect to new claims 46-48.

Applicants respectfully assert, for example, that Tagawa fails to teach or suggest limitations of new independent claims **46-48**. In particular, Tagawa fails to teach or suggest *a selling step to sell the undisclosed one of the two or more products to the customer for the single sales price and to reveal the identity of the undisclosed one of the two or more products to the customer*.

Tagawa is directed to a self-service travel services purchasing system. Nowhere does Tagawa teach or suggest allowing a customer to purchase an “undisclosed” service and then only “revealing” the identity of the purchased service after the purchase has been made. In Tagawa, for example, a customer is presented with various itinerary products (*e.g.*, flights), selects an option for purchase, and purchases the selected product.

In contrast, currently claimed embodiments (such as recited in new claims **46-48**) provide for a customer to purchase one of a plurality of “undisclosed” products (*e.g.*, a purchase of one of a number of available flights to a destination), without “revealing” the specific product (*e.g.*, the specific flight) to the customer until after the purchase (or commitment to purchase) is made. The advantages of such a limitation are extensively described in the specification of Applicants’ pending application, as filed.

Accordingly, at least because Tagawa fails to teach or suggest *a selling step to sell the undisclosed one of the two or more products to the customer for the single sales price and to reveal the identity of the undisclosed one of the two or more products to the customer*, Tagawa fails to anticipate new independent claims **46-48**. Applicants therefore respectfully request that this §102(b) rejection be withdrawn.

#### **B. Rejections Under §103(a) – Tagawa**

Claims **31-33**, **35-40**, and **42-45** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Tagawa. Applicants respectfully traverse this ground for rejection as follows.

It is well settled that the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an un-rebutted *prima facie* case of obviousness. *In re Rouffet*, 47

U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 5 U.S.P.Q.2d 1596, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. *Cardiac Pacemakers v. St. Jude Medical* 381 F.3d 1371, 1376 (Fed. Cir. 2004). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2D 1313, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. *In re Grabiak*, 226 U.S.P.Q. 870, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would *prima facie* have been obvious. *Id.* The absence of such a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 42 U.S.P.Q.2D 1378, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

The Examiner has rejected claims 31-33, 35-40, and 42-45 as unpatentable over Tagawa. The Examiner admits that Tagawa fails to disclose the steps of claims 31, 36, and 42-43 “in the claimed order”, yet argues that the timing or order of claimed steps “attributes no patentable differences apart from Tagawa.” Office Action mailed July 5, 2005, pg. 4, first paragraph. In other words, it appears that the Examiner is arguing that it would have been obvious to one of ordinary skill in the art, at the time of invention, to modify Tagawa to perform the claimed steps in the claimed order. However, the

Examiner has not provided any explanation as to what teaching or suggestion in this reference, either alone or in combination with any other reference, teaches or suggests the limitations of claims **31**, **36**, and **42-43** or the order in which they are performed.

Applicants have carefully reviewed the reference and have failed to find any teaching or suggestion that would even remotely suggest the limitations of claims **31**, **36**, and **42-43** being performed in the order claimed.

For example, the Examiner provides no reasoning (or evidence) as to why one of ordinary skill in the art would modify Tagawa to sell an “undisclosed” product to a customer and only after the sale “revealing” the identity of the product to the customer.

Accordingly, at least because the Examiner has failed to establish a *prima facie* case for obviousness, Applicants respectfully request that this §103(a) ground for rejection be withdrawn


### III. Conclusion

At least for the foregoing reasons, it is submitted that all claims are now in condition for allowance, or in better form for appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at [cfincham@walkerdigital.com](mailto:cfincham@walkerdigital.com), at the Examiner's convenience.

Respectfully submitted,

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